

REMARKS/ARGUMENTS

Claims 1-61 are pending in the above-identified application. Claims 1-44 and 57-61 were indicated to be allowable. Claims 45-56 were rejected.

I. **Rejection Under 35 U.S.C. §103(a)**

Claims 45-56 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Chow (U.S. Pat. 6,167,910) ("Chow"). Applicant respectfully traverses because 35 U.S.C. §103(c) disqualifies Chow as being prior art under §103(a).

35 U.S.C. Section 103(c), effective November 29, 1999, provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c) applies to all applications filed on or after November 29, 1999 including continuing applications filed under 37 CFR 1.53(b). See MPEP Section 706.02(k).

The instant application was filed on September 1, 2000 as a continuation-in-part under 37 CFR 1.53(b), so the provisions of 35 U.S.C. § 103(c) that became effective on November 29, 1999 apply. Under the November 29, 1999 revision of 35 U.S.C. § 103(c), a reference that qualifies as prior art only under one or more of 35 U.S.C. §§ 102(e), (f), or (g), and that is commonly owned or subject to an obligation of assignment to the same person at the time the invention was made, cannot be applied in a rejection under 35 U.S.C. § 103(a). In the present case, the Examiner's 103(a) rejection relies on the Chow reference that was filed on January 14, 1999, and issued on January 2, 2001. The present application was filed on September 1, 2000 as a continuation-in-part of U.S. Patent Application No. 09/394,012, which was filed September 10, 1999. Thus, Chow only qualifies as prior art under § 102(e) (and/or § 102(f) or (g)). Furthermore, both the instant application and Chow were commonly owned by the same present assignee, Caliper Technologies Corp., at the time the claimed invention of the present application was made. Accordingly, the Chow reference cannot be applied in a rejection under 35 U.S.C. § 103(a) under the provisions of 35 U.S.C. § 103(c). Therefore, the pending §103(a) rejection of claims 45-56 cannot be maintained.


II. Information Disclosure Statement

Along with this response Applicants are submitting an Information Disclosure Statement citing one reference, U.S. Patent No. 5,965,237.

CONCLUSION

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (650) 623-0737.

Respectfully submitted,



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